

REMARKS

In the Office Action the Examiner noted that claims 1-6 are pending in the application, and the Examiner rejected all claims. By this Amendment, claim 1 has been amended. No new matter has been presented. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

Claim Rejection Under 35 USC §102

In item 3 on pages 2-3 of the Office Action the Examiner rejected claim 1 under 35 U.S.C. §102(e) as being anticipated by the Applicant's Admitted Prior Art (hereinafter referred to as "AAPA").

Claim 1 of the present application, as amended, recites:

An apparatus generating a seek direction detecting signal for an optical pickup, comprising:

- a light dividing unit dividing an incident light beam into at least two beams including a main beam and a sub-beam so that at least two beam spots, including a main beam spot and at least one sub-beam spot having an optical aberration, can be focused in a track direction of the optical disk, wherein a direction of the optical aberration of the sub-beam spot is a tangential direction of an optical disk, and the main beam spot and the sub-beam spot are formed on a same track of the optical disk;

- an optical detector unit including:

- a first optical detector receiving the main beam, and converting the portions of the received beam into electrical signals independent of each other, and

- a second optical detector receiving the sub-beam and converting the portions of the received beam into electrical signals independent of each other, wherein the first and second optical detectors comprise a plurality of light receiving portions;

- a signal processing portion including:

- a first signal processing portion processing a track error signal from the signals output from the first optical detector, and

- a second signal processing portion processing a track cross signal from the signals output from the second optical detector; and

- a generator generating the seek direction detecting signal from a phase difference between the track cross signal and the track error signal.

Therefore, the incident light beam is divided into at least two beams including a main beam and a sub-beam "so that at least two beam spots, including a main beam spot and at least one sub-beam spot having an optical aberration, can be focused in a track direction of the optical disk, wherein a direction of the optical aberration of the sub-beam spot is a tangential direction of an optical disk, and the main beam spot and the sub-beam spot are formed on a same track of the optical disk." Thus, the main beam spot and the sub-beam spot are formed on the same track of the optical disk.

The Examiner states that AAPA discloses "dividing an incident light beam into at least

two beams including a main beam and a sub-beam so that at least two beam spots including a main beam spot and at least one sub-beam spot having an optical aberration, can be focused in a track direction of an optical disk, wherein a direction of the optical aberration of the sub-beam spot is a tangential direction of the optical disk [spec. Pgs. 1-30]." However, the main beam and the sub-beam of AAPA are separated from each other by a $\frac{1}{2}$ track pitch in the radial direction.

Figure 1 of the present application illustrates a main beam and two sub-beams of AAPA. It is clearly shown that the sub-beams are each separated from the main beam by a $\frac{1}{2}$ track pitch, each of the sub-beams being offset in opposite directions from the main beam. This is supported by paragraph 5 of the present application, which states "first and second sub-beams B_{S1} and B_{S2} , in which each sub-beam precedes or follows the main beam B_M by a predetermined time, are focused on tracks of the optical disk 1 to be $\pm 1/2$ track pitch off the main beam B_M in the radial direction of the optical disk 1" (Paragraph 5). This is in direct contrast to claim 1 of the present application, which recites "at least two beam spots, including a main beam spot and at least one sub-beam spot having an optical aberration,and the main beam spot and the sub-beam spot are formed on a same track of the optical disk."

Therefore, AAPA does not disclose the feature of "at least two beam spots, including a main beam spot and at least one sub-beam spot having an optical aberration,and the main beam spot and the sub-beam spot are formed on a same track of the optical disk." Accordingly, AAPA does not disclose every element of the Applicant's claim 1. In order for a reference to anticipate a claim, the reference must teach each and every element of the claim (MPEP §2131). Therefore, since AAPA does not teach the features recited in independent claim 1, as stated above, it is respectfully submitted that claim 1 patentably distinguishes over AAPA, and withdrawal of the §102(e) rejection is earnestly and respectfully solicited.

Claim Rejections Under 35 USC §103

In items 4-8 on pages 3-6 of the Office Action the Examiner rejected claims 2-6 under 35 U.S.C. §103(a) as being unpatentable over AAPA as applied to claim 1 and in view of U.S. Patent No. 6,147,952, issued to Watabe (hereinafter referred to as "Watabe").

Claims 2-6 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by AAPA or Watabe. As presented in the preceding argument, AAPA does not disclose the feature recited by claim 1 of "at least two beam spots, including a main beam spot and at least one sub-beam spot having an optical aberration,and the main beam spot and the sub-beam spot are formed on a same track of

the optical disk." Further, this deficiency by AAPA is not cured by Watabe. Therefore, it is respectfully submitted that claims 2-6 also patentably distinguish over AAPA and Watabe, either taken alone or in combination.

Examiner's Reply To Applicant's Arguments

The Examiner has addressed the traversal made to the §102 rejection in the Amendment filed on February 9, 2004. The Examiner addressed the traversal made in relation to the §103 rejection in item 10 on pages 6-7 of the Office Action, quoting a section of the Applicant's traversal of the §103 rejection. The Examiner indicated that the cited section was not persuasive because "claim 1 does NOT use Watabe at all." However, the section of the reply cited by the Examiner was not traversing the claim 1 rejection, but was merely pointing out that Watabe possessed the same deficiency as AAPA regarding a patentable feature recited in claim 1. Therefore, while the Examiner did address the Applicant's §103 traversal, this Final Rejection was silent to the traversal made to the §102 rejection regarding AAPA.

As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal.

Additionally and as further noted in MPEP 707.07(f), a failure of the Examiner to address the applicant's traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).

As such, since the Examiner has not addressed the applicant's traversals presented in the Amendment of February 9, 2004, it is respectfully requested that the Examiner withdraw the Final Office Action and issue a new Office Action addressing the Amendment of February 9, 2004.

This failure to address the applicant's traversals was also noted in the Amendment filed on June 15, 2004, and was not addressed in the Advisory Action mailed June 23, 2004. Therefore, the Examiner has not yet addressed either the applicant's traversals presented in the Amendment of February 9, 2004, nor the request made on June 15, 2004 that the Examiner withdraw the Final Office Action and issue a new Office Action accordingly. The applicant

respectfully requests that the Examiner address these matters in the next issued Office Action.

Summary

In accordance with the foregoing, claim 1 has been amended. No new matter has been presented. Thus, claims 1-6 are pending and under consideration.

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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07/15/04

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